

### Remarks

Entry of this amendment, reconsideration of the application, and allowance of all claims are respectfully requested. Independent claims 1, 8 & 15 are amended herein to specify that Applicants' technique includes tracking a length of time that the status indicator has each of the entered setting, the audit passed setting, and the audit failed setting, and the re-entered setting, wherein the length of time is employed to audit the invoice entry. These amendments constitute a *bona fide* attempt by Applicants to advance prosecution of the application and obtain allowance of certain subject matter, and are in no way meant to acquiesce to the substance of the final rejection. No new matter is added to the application by any amendment presented. Support for the amendments to the claims can be found at page 6, line 27 – page 7, line 13 of the specification (as well as page 8, lines 15-21 (for new claims 18 & 19)).

Claims 1-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gillings et al. (U.S. Patent No. 5,666,490; hereinafter "Gillings") in view of Rapp, III (U.S. Patent No. 6,400,997; hereinafter "Rapp"), and various "common in the art" assertions by the Examiner. This rejection is respectfully traversed and its reconsideration is requested.

An "obviousness" determination requires an evaluation of whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art. In evaluating claimed subject matter as a whole, the Federal Circuit has expressly mandated that functional claim language be considered in evaluating a claim relative to the prior art. Applicants respectfully submit that the application of these standards to the independent claims presented herewith leads to the conclusion that the recited subject matter would not have been obvious to one of ordinary skill in the art based on the applied patents. Rather, in analyzing the independent claims presented herewith "as a whole", it is respectfully submitted that there are numerous features of Applicants' claimed technique which are simply not taught, suggested or implied by Gillings or Rapp, alone or in combination. These features are discussed below in the order recited in the pending claims.

Applicants recite a method of invoice entry (e.g., claim 1) which includes entering data from an invoice, by a first person, into a first database having a status indicator associated with the data from the invoice, and setting the status indicator to entered. Accuracy is insured by a subset of the data from the invoice then being entered by a second person different from the first person, into the same database. The technique then matches the subset of data entered by the second person with the corresponding subset of data entered by the first person and highlights any unmatched entries. This is an audit of the data entered by the first person into the database. Subsequent to the matching step, any unmatched entries are re-entered by the second person, and the status indicator is changed to audit passed or the status indicator is set to audit failed, or the status is set to audit passed if there are no unmatched entries. Thereafter, the entered invoice data by the first person is posted to a second database if the status indicator is audit passed, otherwise, the first person re-enters the unmatched entries, and changes the status indicator to re-entered, and thereafter proceeds to the matching step, or changes the status indicator to cancel, thereby canceling the data entered by the first person. While data is being entered by the first and/or second person, a length of time that the status indicator has each of the entered setting, audit passed setting, audit failed setting, and re-entered setting is tracked. This length of time is employed to audit the invoice entry process. (Additionally as recited in claims 16 and 17, entered invoice data can be deleted from the first database if the length of time that the status indicator has had a particular one of the settings exceed a predefined threshold.)

Although Gillings does discuss a technique for accurately entering data into a document management system, the process described therein does not teach, suggest or imply the functionality of Applicants' claims when viewed "as a whole". By way of example, and as acknowledged in the Office Action, Gillings does not disclose entering data from an invoice. The Office Action, however, alleges that it would have been obvious to one of ordinary skill in the art to employ the teachings of Gillings with entering of data from an invoice. This conclusion is respectfully traversed. Gillings expressly teaches that the purpose of their patent is to manage scientific case report forms. Gillings does not discuss invoices, nor does it address any need for accurately entering data from an invoice into a database. Gillings discusses entering data from a "specific case report form" only.

The Office Action further alleges that Gillings discloses a status indicator that indicates a state of the document, and the required actions to be taken, and then alleges that it must be inherent in Gillings that these actions to be taken include states such as “entered” or “audit passed”. Applicants note that the Office Action does not mention an “audit failed” setting or a “re-entered” setting, both of which are set forth in the independent claims presented.

With respect to an inherency rejection, Applicants respectfully submit that the doctrine of inherency is well-settled in patent law, and is best described in an excerpt from Hansgirk v. Kemmer, 26 C.C.P.A. 937, 102 F.2d 212, 40 U.S.P.Q. 665 (1939):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [citations omitted.] If, however, the disclosure [of the cited reference] is sufficient to show that the natural results flowing from the operation as taught would result in the performance of the questions function, it seems to be well settled that the disclosure should be regarded as sufficient [to anticipate the claimed invention].

Id. At 940, 102 F.2d at 214, 40 U.S.P.Q. at 667; Stoller v. Ford Motor Co., 18 U.S.P.Q. 2d 1545, 1547 (Fed. Cir. 1991); Tyler Refrigeration v. Kysor Industrial Corporation, 227 U.S.P.Q. 845, 847 (Fed. Cir. 1985); Ex parte Levy, 17 U.S.P.Q. 2d 1461, 1464 (B.P.A.I. 1990); In re Oelrich and Divigard, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

In Ex parte Levy, the court state that “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” Ex parte Levy, 17 U.S.P.Q. 2d at 1464 (lengthy citation omitted) (italics added). The Examiner has neither pointed to any passage in Gillings where the specific status indicator settings recited in Applicants’ process are disclosed, nor set forth any technical reasoning to support an inherency rejection of the cited functional language. Absent such a showing, it is well established that the claims are to be read in their entirety, including any functional limitations presented therein.

Applicants recite the entering of data from an invoice, by a first person, into a database having a status indicator associated with the data from the invoice, and setting the status indicator to “entered”. As Applicants’ data invoice entry process proceeds, the status indicator is changed between one or more of the “entered” setting, an “audit passed” setting, an “audit failed” setting, and a “re-entered” setting. The Office Action cites column 7, lines 35-44 of Gillings, as well as FIG. 9 thereof for an alleged teaching of this aspect of Applicants’ invention. Without acquiescing to this citation, Applicants note that Gillings does not disclose the use of a status indicator as an integral part of a process as specifically recited by Applicants. In Applicants’ recited process, the status of the indicator is used in various conditional statements in deciding how to proceed through the functionality recited. Applicants are not merely reciting a status indicator, but rather reciting functionality that is entwined with the various states of the status indicator. A careful reading of Gillings fails to uncover any suggestion or implication of such functionality.

Additionally, Applicants independent claims recite tracking a length of time that the status indicator has each of an “entered” setting, an “audit passed” setting, an “audit failed” setting, and a “re-entered” setting. This length of time is then employed to audit the invoice entry process. As recited in the independent claims, the “entered” setting is achieved when data is entered from an invoice by a first person into a first database. The “audit passed” setting results from entering a subset of the data from the invoice by a second person different from the first person into the first database and then matching the subset of the data entered by the second person with data entered by the first person and setting the status indicator to “audit passed” if there are no unmatched entries, otherwise re-entering the unmatched entries by the second person and changing the status indicator to “audit passed”. Alternatively, the unmatched entries can result in setting of the status indicator to “audit failed”. Thereafter, the technique includes posting the entered invoice data by the first person to a second database if the status indicator is “audit passed” or re-entering the unmatched entries by the first person, changing the status indicator to “re-entered” and thereafter proceeding to the matching step. Within such a process, Applicants further recite tracking a length of time that the status indicator has each of the “entered”, “audit passed”, “audit failed”, and “re-entered” settings. For an alleged teaching of Applicants’ prior “at least one” claim language, the Office Action references Gillings in

combination with Rapp. This citation is respectfully traversed to any extent deemed applicable to the amended claims presented herewith.

The Office Action acknowledged that Gillings does not teach the step of tracking a length of time that an indicator is set at “entered”. Rapp is cited for allegedly teaching one of ordinary skill in the art this aspect of Applicants’ invention. Specifically, Rapp describes tracking the amount of time an operator spends setting up a work center according to instructions for a job which is displayed in the job information section of a main job window (column 11, lines 59-65 & column 13, lines 28-32).

Initially, Applicants submit that the claims presented herewith track a different time interval than that taught by Rapp. Rapp teaches tracking a length of time required for setup by an operator, which is functionality not claimed by the present invention. In Applicants’ independent claims, a length of time that the status indicator is in each of four states is tracked. Again, the status indicator refers to the four specific states summarized above. Because neither Gillings nor Rapp teach, suggest or imply Applicants’ functionality entwined with the various recited states of the status indicator, neither patent would suggest to one of ordinary skill in the art tracking a length of time that such a status indicator has each of the four states identified, and then using the length of time to audit the invoice entry process.

Further, and as acknowledged in the Office Action, Gillings does not disclose Applicants’ recited functionality of re-entering any unmatched entries by the first person (nor changing the status indicator to re-entered and thereafter proceeding to the matching step, or changing the status indicator, by the first person to cancel). The Office Action simply alleges that re-entering the data by the first person in order to resolve the discrepancies, as taught by Gillings, would be obvious without any support for this conclusion.

Thus, Applicants respectfully submit that a *prima facie* case of obviousness has not been stated in the final Office Action. To the extent that the Examiner is relying on personal knowledge to support a finding of what is known or common in the art, the Examiner is

requested to provide an Affidavit or Declaration setting forth specific factual statements and an explanation to support such a finding in accordance with 37 C.F.R. §1.104(d)(2).

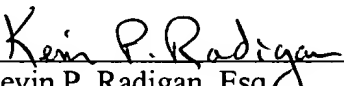
Still further, Applicants' respectfully submit that the independent claims presented recite posting the entered invoice data by the first person to a second database if the status indicator is audit passed. This step of posting the entered invoice data by the first person to the second database if the status indicator is audit passed is simply not taught, suggested or implied by Gillings. Gillings does not teach moving data by the first person to a second database once the accuracy of the entered invoice data has been ensured and the status indicator is audit passed. Using Applicants approach, the first database may comprise a data changeable database as represented by the re-entering step, while the second database is the ultimate database to which the data is to be posted. Gillings does not suggest or imply such a technique. Only audit passed data in Applicants' invention is moved to the second database.

For all the above reasons, Applicants respectfully request reconsideration and withdrawal of the obviousness rejection to the independent claims presented herewith based upon the teachings of Gillings and Rapp.

The dependent claims are believed allowable for the same reasons as the independent claims, as well as for their own additional characterizations. For example, claims 16 & 17 further recite deleting entered invoice data from the first database if the length of time that the status indicator has had one of the settings exceeds a defined threshold. Neither Gillings nor Rapp suggest such deleting in the context of an invoice entry process such as recited by Applicants.

If the Examiner wishes to discuss this application with Applicants' attorney, the Examiner is invited to contact their below-listed representative. The application is believed to be in condition for allowance and such action is respectfully requested.

Respectfully submitted,

  
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